



IN THE UNITED STATES PATENT OFFICE

Serial No. 09/473,702 :
Filing Date: 12/29/99 :
Inventor: Evan Howard Lott :
Invention: Method and Apparatus to : Group Art 3626
Identify Uninsured Motorists :
Examiner: A. Kalinowski :

#171 Response to Rule 6
105 Required
for info / filed
9/29/03
S. Ellis

SECOND COMMUNICATION PROVIDING
REQUIRED INFORMATION UNDER 37 C.F.R. §1.105

COMMISSIONER OF PATENTS
Washington, D.C. 20231

RECEIVED
SEP 23 2003
GROUP 3600

Sir:

The Examiner's courtesy in extending an office interview on 8/8/03 with co-counsel Allen Turner of TraskBritt to discuss the Examiner's inquiry pursuant to 37 C.F.R. §1.105 is appreciated. The Examiner requested that the brochures, pamphlets and the like which were available from Insure-Rite on or before its website dated about November 11, 1998 be listed in an Information Disclosure Statement. Said Information Disclosure Statement is attached to the Supplemental Affidavit of Richard Kasteler listing these documents by date and discussing in more detail the Insure-Rite archival web site attached to the Office Action mailed 7/2/2003. The attachments to this second affidavit are the same as those attached to his prior affidavit. Given the volume of those attachments, a second identical set has not been provided again.

The Examiner also required Applicant to address the "patent pending" notation included on Insure-Rite's web site and an affidavit by inventor Evan Lott, and disclose any patent applications being referred to. As outlined in the Supplemental Affidavit and an affidavit by inventor Evan Lott, Insure-Rite's web site did not contain the notation "patent pending" until after the instant patent application had been filed. Also the web site as referred to by Examiner incompletely described Applicant's insurance verification system:

a. The archival website refers to a system with "a margin of error as little as plus or minus 5% (web site page 2, second paragraph). The present method provides an accuracy report in excess of 95% accuracy.

b. The archival website described a system, which only compiled "a database drawn from all insurance companies providing personal or commercial automobile coverage within the state" (web site page 1, last paragraph). That presentation, as stated, is inconsistent with the claimed system which employs all available accurate, inaccurate, repetitive, complete and incomplete information not only from insurance carriers, but the motorist licensing divisions, and vehicle registration divisions (Base Claim 12). The system under experimental test in 1998 and 1999 did employ multiple database inputs, but the information on the web site available to the public did not disclose that.

There were no patent applications filed prior to the instant application inasmuch as the invention was still being tested. The usage of the "patent pending" notation was not included on the web site until April 29, 2000 after the patent application was filed on December 29, 1999; see affidavit of Evan Lott. This can be verified by the Examiner accessing subsequent files from the web site archives. Since the web site did not contain the "patent pending" notation until after testing was completed and the patent application filed, there was no suggestion earlier from which it can be inferred that Insure-Rite deemed the system to be "patent ready." It is therefore submitted that the numerous documents appended to the affidavits of Richard Kasteler establish the following:

1) No disqualifying public use or disclosure of the invention occurred prior to the filing date of the application.

2) A lengthy experimentation period was undertaken in 1992 to begin processing information provided by the State of Utah; the initial system employed was only marginally effective and testing on it was conducted for about 4 years.

3) The method disclosed and claimed in the pending patent application was developed during 1996-97-98 and underwent an experimentation period of about 2 years before finally being proven to be accurate in the year 2000, when actual reduction to practice occurred. (Constructive reduction to practice took place upon the filing of the patent application on December 29, 1999.)

4) The experimentation was largely funded by the State of Utah, however, a confidentiality agreement was in place and no sale nor offer to sell nor disqualifying public use of the system occurred. All aspects of the invention were under the control and administration of the inventor and Insure-Rite.

5) No other patents were filed disclosing Applicant's insurance verification method.

A full disclosure of all pertinent documents has been provided for the Examiner's benefit and for the benefit of any future review of the application file. The conclusions set forth herein that the application is not barred by any "public use" or "offer for sale" is supported by controlling case law as applied to the facts, as previously discussed in the earlier Communication.

The Affidavit of Richard Kasteler, President of Insure-Rite, Inc., who conducted the records search submits a number of documents outlining the system services relating to the disclosed subject matter of a method for identifying uninsured motorists referenced in the Insure-Rite, Inc. web site dated 11/11/1998. These documents discuss Applicant's method from its initiation through development during an extensive testing program mandated by the State of Utah before it was awarded an administrative contract in 2000—over a year after the filing date.

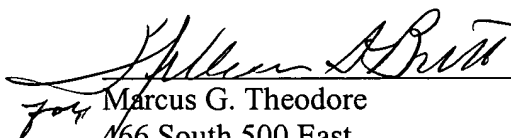
The method of the patent application was conceived in 1996-97-98, when Applicant's employee Evan Lott extensively revised the method to accommodate the legislative revisions required in 1996-7 (see legislative history of Sec. 41-121-801 et seq., U.C.A., 1953, as amended, submitted previously as Exhibit A) of the database and law enforcement notices and reports. His method involved the input of all raw data of available accurate, inaccurate, repetitive, complete, and incomplete information from all sources (insurance companies, state driver's license records, and state auto registration records) without pre-screening or formatting to produce a system which would, if successful, achieve an in excess of 95% accuracy statewide list of uninsured motorists. Algorithms were revised and new ones were used in Lott's method. This inventive method was counterintuitive to past approaches, which required pre-screening of data. It was then tested on the expanded entire Utah statewide database to ensure its accuracy pursuant to the terms of a confidential Software License Agreement, a copy of which is attached as Exhibit B. (paragraph 10, Affidavit Richard Kasteler). It is worthy of note that the License Agreement was prospective in nature with its effective date being such future date that Insure-Rite would be defunct and the State would have to take over the actual operation of the system. This has never happened and Insure-Rite has always been the administrator and operator of the system.

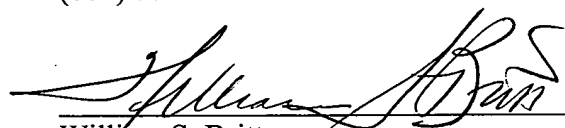
In 2000, the method was finally deemed sufficiently reliable by the State of Utah for law enforcement purposes. Only then could it be said to be reduced to practice. Applicant proceeded

to use its state approved method to administer and track all uninsured and insured motorists in the State of Utah. The extensive experimentation period was the only reasonable way under the circumstances to verify the usefulness of the invention, and constitutes permissive pre-filing behavior.

Since none of the above activities were for market testing, but were to establish the revised method's operational reliability in processing unscreened, continually-changing statewide insurance, automobile, and driver data in changing formats to produce in excess of 95% accurate lists of uninsured motorists, Applicant's public testing use of its insurance verification method prior to 12/29/99 was not commercial usage barring patent coverage. Applicant therefore respectfully requests that the latest amendments be entered, and the patent application be allowed to issue. If the Examiner has additional questions, or requires additional information, a telephonic conference is requested.

Dated this 29th day of August 2003.


For Marcus G. Theodore
466 South 500 East
Salt Lake City, Utah 84102
(801) 359-8622


William S. Britt
TraskBritt
230 South 500 East #300
Salt Lake City, Utah 84102
(801) 531-9168
Attorneys for Applicant

CERTIFICATE OF MAILING

I certify that I over night mailed the foregoing Second Communication and Supplemental Affidavit to Examiner Kalinowski, Crystal Park Five Building, Seventh Floor in Crystal City, Virginia 22202 (703) 305-7687, this 29th day of August 2003.

